

U.S. Patent Application Serial No. 10/665,733
Amendment filed January 15, 2008
Reply to OA dated August 15, 2007

REMARKS

The specification has been amended in order to more particularly point out, and distinctly claim the subject matter to which the applicants regard as their invention. The applicants respectfully submit that no new matter has been added. It is believed that this Amendment is fully responsive to the Office Action dated August 15, 2007.

With respect to the Examiner's comment on the claim for priority, in the first full paragraph on page 2 of the outstanding Office Action, the applicants submit that in September 19, 2003 (30 months from the foreign priority date), the U.S. PTO was closed, due to a hurricane. Further, September 20 and 21, 2007 fall on Saturday and Sunday, respectively, in which the U.S. PTO was also closed. Thus, the filing of the application on September 22, 2007 should suffice for the purpose of claiming the priority date of March 19, 2001.

The Examiner cites "paragraph 5 of the preferred embodiments," which appears to be an incorrect citation because the mention of Fig. 6(a) occurs in the specification at page 15, line 6, and nowhere else. In any event, the applicants have amended the paragraph at issue at page 15, lines 5 - 20.

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Accordingly, the withdrawal of the outstanding objections set forth in the second full paragraph on page 2 of the outstanding Action is in order, and is therefore respectfully solicited.

As to the merits of this case, claims 1, 3 - 7, 10 - 13 and 15 are rejected under 35 U.S.C. §102(b) as being anticipated by Ito (U.S. Patent No. 6,039,250). The applicants respectfully request reconsideration of this rejection.

Ito's object is to transfer electronic money without the need for both parties to the transaction to be in communication (col. 1, lines 22-38), which is called an "indirect remittance" (col. 4, line 36). Ito's "indirect remittance" is a method for transferring electronic money between both parties through the electronic money server 3. Ito provides an intermediary to store the electronic money for this purpose. Also, Ito discloses that "IC cards 4, 5 are storage media for electronic moneys."

Ito's system typifies the "open-loop system" that is described in the applicants' specification at page 1, line 13, in which individuals can transfer funds to each other. The applicants' specification states that its object is to permit person-to-person transfers in a closed-loop system. That is, Ito's type of transferring of the electronic money is the "open-loop type," in which the electronic money is directly transferred between the IC cards.

More particularly, the electronic money server 3 of Ito has IC card 6 (col 3, lines 63-67); and the electronic money is merely transferred from IC card 4 of the remitter to IC card 6, and from IC card 6 to IC card 5 of the receptor.

On the other hand, the applicants' claimed invention is for a closed-loop type transfer of the electronic money, which has to balance a bank account relating the electronic money of each user when transferring the electronic money from a user to another user.

Also, while Ito's electronic money server 3 sends an e-mail to confirm the reception of the electronic money (S207) (col.5, lines 1-3), the applicants' instant claimed invention sends a program by using an e-mail, the program being for depositing an electronic money of the first user into the storage means of the second user. Since the receptor having the IC card is necessary to obtain the program to receive the electric money in addition with providing the IC card, safer transfer of the electronic money is achieved in the applicants' claimed invention.

Accordingly, it is the applicants' position that Ito does not disclose at least the following elements set forth in claim 1: "a generating a program for depositing an electronic money amount equivalent to the remittance in the storage means of the second user based on the remittance order information" (Ito does not generate the program); "subtracting the amount equivalent to the remittance from a predetermined account balance related the first user" (Ito does not balance the

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bank account of the electronic money); “transmitting a program to a terminal for use by the second user” (Ito does not send the program); “receiving a remittance instruction transmitted from the terminal for use by the second user as a consequence that the program received by the terminal for use by the second user is executed by said terminal” (Ito does not execute the program to receive the remittance instruction); and “adding the amount equivalent to the remittance to an electronic money management account balance related to the electronic money stored in the storage means of the second user” (Ito does not balance the bank account of the electronic money).

In view of the above, the applicants submit that not all of the claimed elements or features of the applicants’ claimed invention are found in exactly the same situation and united in the same way to perform the identical function in Ito’s system. Thus, there can be no anticipation under 35 U.S.C. §102(b) of the applicants’ claimed invention.

Accordingly, the withdrawal of the outstanding anticipation rejection under 35 U.S.C. §102(b) based on Ito (U.S. Patent No. 6,039,250) is in order, and is therefore respectfully solicited.

As to the outstanding obviousness rejection, claims 2, 8, 9, and 14 are rejected under 35 U.S.C. §103(a) as being obvious over Ito in view of *The Electronics Communicator*. The applicants respectfully request reconsideration of this rejection.

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Although the Examiner has applied an article from *The Electronics Communicator* in the rejection, the applicants submit that the Examiner has not supplied the applicants' undersigned representative with a copy and there is no citation to the text of the article. The Examiner appears actually to rely upon Official Notice, repeatedly making statements of the form, "Ito does not teach [a feature]. Therefore, it would have been obvious to [modify Ito to include the feature]," and does not present any specific or technological reason for combining the teachings of the cited references. At the least, the applicants request for a marked-up copy of this reference.

It is thus submitted that the teachings of the cited prior art references cannot be combined in the manner suggested by the Examiner, and that the applicants' claimed invention would not have been obvious under 35 U.S.C. §103(a) based on the teachings of Ito in view of *The Electronics Communicator*. In view of the above, the withdrawal of the outstanding rejection under 35 U.S.C. §103(a) based on Ito in view of *The Electronics Communicator* is in order, and is therefore respectfully solicited.

In view of the aforementioned amendments and accompanying remarks, specification as amended, are in condition for allowance, which action, at an early date, is requested.

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If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact the applicants' undersigned attorney at the telephone number indicated below in order to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, the applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper to Deposit Account No. 01-2340.

Respectfully submitted,

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Enclosure: Petition for Extension of Time